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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,591	10/02/2003	Joonas Paalasmaa	915-005.071	6157
4955 7590 02/26/2007 WARE FRESSOLA VAN DER SLUYS & ADOLPHSON, LLP BRADFORD GREEN, BUILDING 5 755 MAIN STREET, P O BOX 224 MONROE, CT 06468			EXAMINER VEILLARD, JACQUES	
			ART UNIT 2165	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/26/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/678,591

Applicant(s)

PAALASMAA ET AL.

Examiner

Jacques Veillard

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>01/22/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the Applicant's communication filed on 01/22/2007.
2. Claims 1-28 have been canceled, claims 29-35, 39-41, 43-45, 48, and 55-57 amended.
3. Claims 29-57 are pending and presented for examination.

Continued Examination Under 37 CFR 1.114

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 22, 2007 has been entered.

Information Disclosure Statement

5. The information disclosure statement filed 01/22/2007 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because one of the references listed on the 1449 form fails to list the reference publishing's date. According, it has been placed in the application file, the information referred to therein has been considered as to the merits. However, the strikethrough reference in the form has not been considered because it does not have a published date.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 34 and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term “other” recites in line 3 of claim 34, and in line 4 of claim 48, is a relative term which renders the claim indefinite. The term “other” is not defined by the claim, the specification does not provides a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. The limitation “other” is indefinite due to the possible meanings of the word, being the one (as of two or more), ones distinct from that, one that remains of two or more, etc. Therefore, given “other” any of the common and broadest definitions it is unclear to the Examiner what the limitation “other” is intended to cover.

Furthermore, There is insufficient antecedent basis for the limitation “the other descriptive information” recites in line 3 of claim 34, and in line 4 of claim 48.

Claim 48 recites the pronouns “those” and “that” in line 4. The pronouns “those” and “that” are not permitted as part of the claimed language; only what is being referred by “those” and “that” should be set in the claim.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 29-42, and 55 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The independent claims 29 and 55 are directed to a method and a computer program product for managing media items comprising a few steps. However, the claimed subject matter lacks a practical application of a judicial exception (law of nature, abstract idea, naturally occurring article/phenomenon) since the claims fail to produce a useful, concrete and tangible result. Specifically, the claimed subject matter, as claimed in claims 29 and 55, does not produce a tangible result because the claimed subject matter fails to produce a result that is limited to having real world value rather than a result that may be interpreted to be abstract in nature as, for example, a thought, a computation, or manipulated data. More specifically, the claimed subject matter in combination with the providing..., forming..., provides a final result of presenting each cluster and any sub-cluster as an individual media item. The presenting step is not claimed as applied in a practical application, which provides a tangible, i.e., real world result.

This produced result remains in the abstraction and, fails to achieve the required status of having real world value. As such, claims 29 and 55 are not limited to a statutory subject matter and are therefore non-statutory.

The dependent claims included in the statement of rejection but not specifically addressed in the body of the rejection have inherited the deficiencies of their parent claim and have not resolved the deficiencies. Therefore, they are rejected based on the same rationale as applied to their parent claim 29 above.

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10. Claims 43-54 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, specifically directed toward a functional descriptive material data, per se. Claim 43 recites an apparatus comprising a few steps such as a definer for providing media items..., a grouper for forming cluster of individual media items..., a determiner for determining media items having description information in common within a cluster..., a provider for providing a cluster hierarchy..., and a presenter for presenting each cluster. The claim appears to be at best, functional descriptive material which not claimed as being embodied on a computer readable medium, without the above, the functionality of those instructions steps cannot be realized since it is not directly accessible by computers.

Furthermore, even if the claim were embodied in an appropriate computer readable medium, it would still not be directed to a statutory subject matter because the claimed subject matter lacks a practical application of a judicial exception (law of nature, abstract idea, naturally occurring article/phenomenon) since the claims fail to produce a useful, concrete and tangible result. Specifically, the claimed subject matter does not produce a tangible result and fails to produce a result that is limited to having real world value rather than a result that may be interpreted to be abstract in nature as, for example, a thought, a computation, or manipulated data. More specifically, the claimed subject matter provides a final result of presenting each cluster and any sub-cluster as an individual media item. The presenting step is not claimed as applied in a practical application, which provides a tangible, i.e., real world result.

This produced result remains in the abstraction and, fails to achieve the required status of having real world value. As such, claim 43 is not limited to a statutory subject matter and is therefore non-statutory.

The dependent claims included in the statement of rejection but not specifically addressed in the body of the rejection have inherited the deficiencies of their parent claim and have not resolved the deficiencies. Therefore, they are rejected based on the same rationale as applied to their parent claim 43 above.

11. Claims 56-57 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, specifically directed toward a software data, per se.

The apparatus as disclosed in claims 56-57 is made up of five (5) means. It appears that one ordinary skill in the art could reasonably interpret the apparatus as software, per se. it is clear that each of the means is a software instruction to be executed, thus constitutes functional descriptive material, which not claimed as being embodied on a computer readable medium, without the above, the functionality of those means instructions steps cannot be realized since it is not directly accessible by computers.

It is noted that when functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. However, the invention in claims 56-57 is not being embodied on a computer readable medium. Even if the invention in claims were embodied in an appropriate computer readable medium, it would still not be directed to a statutory subject matter because the claimed subject matter lacks a practical application of a judicial exception (law of nature, abstract idea, naturally occurring article/phenomenon) since the claims fail to produce a useful, concrete and tangible result. Specifically, the claimed subject matter does not produce a tangible result and

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fails to produce a result that is limited to having real world value rather than a result that may be interpreted to be abstract in nature as, for example, a thought, a computation, or manipulated data. More specifically, the claimed subject matter provides a final result of presenting each cluster and any sub-cluster as an individual media item. The presenting step is not claimed as applied in a practical application, which provides a tangible, i.e., real world result.

This produced result remains in the abstraction and, fails to achieve the required status of having real world value. As such, claims 56-57 are not limited to a statutory subject matter and is therefore non-statutory.

Examiner's Remarks

12. The application has been thoroughly reviewed the Examiner respectfully submits that would allowed over the prior art made of record if rewritten to overcome the 35 U. S.C. 112. second paragraph and the 35 U. S.C. 101 rejections set forth above.

Prior Art Made of Record

13. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. U.S. patents and U.S. patent application publications will not be supplied with Office actions. Examiners advises the Applicant that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov), from the Office of Public Records and from commercial sources. For the use

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of the Office's PAIR system, Applicants may refer to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques Veillard whose telephone number is (571) 272-4086. The examiner can normally be reached on Mon. to Fri. from 9 AM to 4:30 PM, alt. Fri. off..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272- 4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

J.V.

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Patent Examiner AU 2165

February 22, 2007


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